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Paper No. 17
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re H.K. Canning, Inc.

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Serial No. 75/319,603

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Stephen Grubb for H.K. Canning, Inc.

Darlene D. Bullock, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

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Before Cissel, Hairston and Rogers, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 7, 1997, applicant filed the above-referenced application to register the mark shown below

on the Principal Register for "canned vegetables; canned soup," in Class 29. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce on these goods. The

application included a translation of the term “FRIJOLES NORTENO” as “Northern beans.”

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the mark applicant seeks to register merely describes the goods set forth in the application, in that it states the name of the canned vegetables or a major ingredient of the soup. Attached as an exhibit to the refusal to register was an entry from the glossary in Food Lover’s Companion, (1995), wherein the “great Northern bean” is described as a large white bean resembling a lima bean in shape, but with a delicate, distinctive flavor.

Applicant prefaced its response to the refusal to register by stating that because the application was based on applicant’s intention to use the mark and could not be converted to the Supplemental Register until use could be established, counsel had no choice but to present arguments in favor of registration on the Principal Register. An argument on the issue of descriptiveness followed this remark.

The Examining Attorney was not persuaded by applicant’s argument, and in the second Office Action, she made the refusal to register under Section 2(e)(1) of the Lanham Act final. After providing her explanation of why

the mark merely describes the goods, she further noted that "the proposed mark appears to be generic as applied to the goods and, therefore, incapable of identifying the applicant's goods and distinguishing them from those of others… Under these circumstances, the Examining Attorney cannot recommend an amendment to proceed under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), or an amendment to the Supplemental Register."

Attached to the final refusal to register were a number of excerpts retrieved from the Nexis® database of publications. These excerpts show the term "northern beans" used as the name of a particular type of beans, just as "lima beans" and "black beans" are terms used to name other kinds of beans. These excerpts repeatedly show northern beans as ingredients in recipes.

Notwithstanding the Examining Attorney's advice against seeking registration on the Supplemental Register, applicant filed an amendment to the Supplemental Register. The Examining Attorney refused to accept the amendment because an application based on the allegation that the applicant intends to use the mark in commerce may not be amended to the Supplemental Register until the applicant files an acceptable amendment to allege use or an acceptable statement of use.

Applicant then amended the application to allege use of the mark in interstate commerce as of November 24, 1998, and amended the application to the Supplemental Register. The amendment also identified the color for which the drawing is lined as yellow[1].

The Examining Attorney responded to the amendment by refusing registration on the Supplemental Register under Section 2(e)(1) of the Act on the basis that the mark is the generic name for the goods. Applicant responded with argument that "FRIJOLES NORTENO" is not generic for the goods set forth in the application.

The Examining Attorney considered applicant's arguments, but was not persuaded by them. She made final "the refusal to register on the basis that the mark is generic." She explained that because applicant's identification-of-goods clause is written broadly, all types of vegetables, including northern beans, are included within it, and that because the mark applicant seeks to register is essentially the Spanish term for ""northern beans," it "is therefore the generic name of the class of goods."

[1] Neither applicant nor the Examining Attorney ever addressed the issue of whether the particular display of applicant's mark, including the use of the color yellow, renders the mark capable of indicating source. Accordingly, it is not an issue before us.

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney submitted appeal briefs, but applicant did not request an oral hearing before the Board.

Along with her brief on appeal, the Examining Attorney submitted a request for remand.[2] Her explanation of why she thinks a remand should be granted appears to be centered around the fact that she referenced Section 2(e)(1) of the Act with respect to the first refusal based on mere descriptiveness, but did not specifically mention Section 23 of the Act when she refused registration on the Supplemental Register.

The request for remand is denied. A careful reading of the application file and the appeal briefs filed by both applicant and the Examining Attorney makes it clear that both applicant and the Examining Attorney understood that the issue in dispute is registrability on the Supplemental Register in view of the Examining Attorney's contention that the term "FRIJOLES NORTENO" is generic in connection with the goods set forth in the application. Although it

[2] When he was contacted by Administrative Trademark Judge Cissel by telephone on February 1, 2001, counsel for applicant stated that he opposed the remand, but that he did not intend to file a written opposition to the request for remand. He also waived his right to file a brief in reply to the Examining Attorney's brief on appeal.

is true that the Examining Attorney failed to cite the appropriate section of the Lanham Act in reference to this refusal, her oversight did not lead to any confusion about the nature of the statutory refusal or the evidence in support of it. Both applicant and the Examining Attorney predicate their arguments on the fact that if the term in question is generic, then it is not registrable on the Supplemental Register because it does not possess the capacity to identify applicant's goods and distinguish them from similar goods produced by others. In fact, as noted above, these are the precise terms used by the Examining Attorney in the second Office Action. In view of these circumstances, remand just to indicate the correct number of the section of the statute which is the basis for refusal is not necessary.[3]

Both applicant and the Examining Attorney acknowledge that the Act prohibits registration of generic terms on the Supplemental Register. We therefore turn to the question

[3] We note here that applicant has argued that by first refusing registration on the Principal Register on the ground that the mark is merely descriptive and then refusing registration on the Supplemental Register because the mark is generic, the Examining Attorney has failed to follow proper examination procedure. This argument is not well taken, however, for the reasons explained in the brief of the Examining Attorney. As has often been stated, a generic term is the ultimate in descriptive terminology. Applicant was advised as early as the second Office Action that the term it seeks to register is generic, and hence incapable of identifying and distinguishing applicant's goods.

of whether or not the refusal to register is appropriate because the term “FRIJOLES NORTENO” is generic in connection with canned vegetables.

In H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986), the Court of Appeals for the Federal Circuit set forth the test for determining whether a designation is generic. First we must ask what the name is for the class of goods or services at issue. Then we must determine whether the relevant public understands the designation sought to be registered to refer primarily to that class of goods or services.

The evidence submitted by the Examining Attorney clearly establishes that “FRIJOLES NORTENO” is generic for applicant’s canned vegetables. There can be no doubt that the articles excerpted from the Nexis® database show the term “northern beans” as the generic name of a vegetable, nor can there be any doubt that “FRIJOLES NORTENO” is Spanish for “northern beans.” Because the Spanish equivalent of a generic term is considered to be a generic term for the purpose of consideration for registration as a trademark under the Lanham Act, “FRIJOLES NORTENO” is no more registrable for canned vegetables than the term “northern beans” would be. See J. McCarthy, McCarthy On

Trademarks and Unfair Competition, Section 11:34 (4th ed.-1999), and cases cited therein. In view of the fact that many of the prospective purchasers of these products in the United States no doubt are familiar with the Spanish language, the evidence of record establishes that both the English term and the Spanish equivalent are understood by the relevant purchasing public as the name of the product. As such, both are incapable of identifying the source of applicant's goods and distinguishing them from similar goods produced by others.

In summary, the mark is unregistrable on the Supplemental Register because its literal component, "FRIJOLES NORTENO," is a generic name for a type of vegetable, and the application specifies the goods with which the mark is used as "canned vegetables."

Decision: The refusal of registration on the Supplemental Register is affirmed.